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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/526,743

03/07/2005

Yoshihiro Kobayashi

2005-0305A

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EXAMINER

HUYNH, KHOA D

ART UNIT

PAPER NUMBER

3751

MAIL DATE

DELIVERY MODE

08/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,743	Applicant(s) KOBAYASHI ET AL.	
	Examiner Khoan D. Huynh	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/11/08 & 05/12/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-20 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,7,10,11,13-16 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,9,12 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/11/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 5, 6, 9, 12 and 17, as presently understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki et al. (JP 2001-270281).

Regarding claims 1, 2 and 9, the Matsuzaki et al. reference discloses a writing implement having various components. The implement has its center of gravity set to the almost intermediate part of the total length of the implement. Even though the Matsuzaki et al. reference does not specifically disclose that the center of gravity is at a position between 20 mm from the tip and a position to the middle of the overall length, and the weight between those positions is not less than 50% of the total weight as claimed, it, however, would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Matsuzaki et al. implement by employing a center of gravity located at such positions so that the weight is not less than 50% since discovering an optimum value for a center of gravity involves only trial and error, especially since the Matsuzaki et al. reference also discloses that its center of gravity is substantially in the middle of the implement with the weight obviously not less than 50% of the total weight in order to provide a configuration that is

easy to operate with a finger and to rotate. Furthermore, even though the Matsuzaki et al. reference does not specifically disclose that the rotational inertia between 4300 and 2500 gf.mm² with the inertia about the center of gravity is 20000 gf.mm² or less as claimed, it, however, would have been obvious to one of ordinary skill in the art at the time the invention was made to employ such values for the rotational inertia since discovering an optimum range of values for the rotational inertia involves only trial and error.

Regarding claims 5, 6, 12 and 17, the part of the implement is formed of a metal having a resin having a low specific gravity between those positions.

Response to Amendment

3. Applicant's amendment, filed on 05/12/2008, to the pending claims is insufficient to distinguish the claimed invention from the cited prior art or overcome the rejections as discussed above.

Response to Arguments

4. Applicant's arguments filed on 05/12/2008 with respect to the pending claims have been fully considered. However, they are deemed not persuasive.

5. Applicant asserts that Matsuzaki et al. does not teach a rotation of inertia and by reducing the rotation of inertia...increases the ability of the writing implement to be smoothly operated in minute, reciprocating, turning motion as disclosed in the instant specification. See remark section, page 6, 4th paragraph. The examiner disagrees.

Firstly, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

And lastly, as stated in the above rejection, even though the Matsuzaki et al. reference does not specifically disclose that the rotational inertia between 4300 and 2500 gf.mm² as claimed, it, however, would have been obvious to one of ordinary skill in the art at the time the invention was made to employ such values for the rotational inertia since discovering an optimum range of values for the rotational inertia involves only trial and error. In other words, the choice of such values for the rotational inertia, i.e. choosing from a finite number of predictable solutions, is not of innovation but of ordinary skill and common sense. *KSR*, 550 U.S. (2007).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa D. Huynh whose telephone number is (571) 272-4888. The examiner can normally be reached on M-F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3751

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khoa D. Huynh/
Primary Examiner, Art Unit 3751